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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,252	03/08/2001	Makoto Ono	JP92000032US1 (590.050)	5562
35195	7590	02/24/2006	EXAMINER	
FERENCE & ASSOCIATES 409 BROAD STREET PITTSBURGH, PA 15143			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	
DATE MAILED: 02/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/802,252	<b>Applicant(s)</b> ONO, MAKOTO	
	<b>Examiner</b> George C. Neurauter, Jr.	<b>Art Unit</b> 2143	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

Claims 1-7 are currently presented and have been examined.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 November 2005 has been entered.

***Response to Arguments***

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant has argued that Ahmad does not teach wherein a license key is generated at the user's terminal. The Applicant has attempted to amend the claim in order to require this feature, however, some of the claims still do not require that the license key be generated in accordance with the broadest reasonable interpretation of the claim.

Note, for example, in claim 1:

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"...transmitting, to said information terminals of said user, either a license key...or information with which said license key can generated at said information terminal..."

Claims 4-7 similarly recite:

"...an information terminal of a user that holds either a license key....or information with which said license key can be generated at said information terminal of said user..."

"...transmitting, from said network provider to said information terminal of said user, a new license key...or...information that can generate said new license key at the information terminal of said user."

As the language of the claims show, the generation of a license key at the user's terminal is still optional and therefore not specifically required. As the Examiner has previously shown, Ahmad discloses wherein a license key is generated at a server and is sent to the user's terminal. Therefore, Ahmad still teaches the limitations of these claims as recited.

The Applicant also argues that Ahmad does not teach wherein the license key is generated according to a program key, a user identification, and an unspecified time component. It is noted that claims 1 and 4-7 do not specifically require that the license key is generated using these elements and simply

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requires that a license key be generated in accordance with the broadest reasonable interpretation of the claim which is taught by Ahmad as shown previously. Also, claims 2 and 3 similarly recite wherein "generating a license key based on specified downloaded program information that is associated with said desired file that is selected by said user and with said user ID that is specified for said IP address...and information that is associated with a license condition for a downloaded program". There is no specific recitation of either a program key or a time as argued; the limitation "specified downloaded program information" is interpreted to include a program name, version information, or a data for updating a license key as disclosed in paragraph 0054 in accordance with the broadest reasonable interpretation of the claim. However, none of these specific elements are recited within the claim. Further, the "program key" that the Applicant argues is not used within Ahmad to generate a license key is also not recited in the claims. Claims 2 and 3 simply require determining if a program key is on the user's terminal and, if not, transmitting a request to connect with a file server and, at a subsequent time, sending the program key along with a license key to the user's terminal. The claims do not recite using the program key to generate a license key.

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Further, it is unclear and the Applicant has failed to address how generating information from which a license key can be generated at a server and sending the information to the information terminal so that the terminal can finally generate the license key is patentably distinct from simply generating the license key at the server and sending the license key to the information terminal. The Applicant has also failed to show support within the specification for such an amendment to the claims. It is requested that the Applicant specifically show the support for such an amendment within the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Claim 5 recites "a subscription manager for...generating a new license key at the information terminal of said user for said downloaded program." This limitation is not described within the specification in order for one of ordinary skill to make and/or use the invention. The specification recites in paragraphs 0039 and 0040 wherein the subscription manager generates a license key for the information terminal.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 recite "...where said program key is not found to be present transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider;..." It is unclear if the steps subsequently recited in the claim are performed when said program key is not found to be present.

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Claims 1 and 3 recite "generating a license key, based on based on specified downloaded program information, that is associated with said desired file that is selected by said user and with said user ID that is specified for said IP address included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a license condition for a downloaded program" It is unclear as specifically what elements are used to generate the license key. It is also unclear as to what elements are associated with the "specified downloaded program information".

Claims 2 and 3 recite "downloading to said information terminal said license key...said program file being capable of referring to said downloaded license key..." There is insufficient antecedent basis for this limitation in the claim.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will assume that this element refers back to the "said license key". See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claims 2 and 3 recite "transmitting said downloaded program specifying information from said information terminal of said user to said network provider" It is unclear as to how the



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downloaded program specifying information is sent to the information terminal.

Claims 2 and 3 recite "based on said user ID and said received downloaded program specifying information generating information from which a new license key can be generated

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5 925 127 to Ahmad.

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Regarding claim 1, Ahmad discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

a user, who uses a network via a network provider under a condition of payment of a connection fee, transmitting a connection request from an information terminal of said user to said network provider ("logs on to Internet"; column 8, lines 54-57);

downloading a program from a server managed by said network provider, or by an entity that has a tie-up with said network provider; (column 8, lines 42-53; column 9, lines 45-49)

transmitting, to said information terminal of said user, either a license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches a predetermined license condition, or information with which said license key can be generated ("CICO module"); (column 9, lines 58-62; column 10, lines 21-34)

again transmitting, at a time subsequent to said immediately preceding step, a connection request that includes said user ID from said information terminal of said user to said network provider; and transmitting, to said information terminal

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of said user, either a new license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches another predetermined license condition, or information with which said new license key can be generated.

(column 14, line 66-column 15, line 5)

Ahmad does not expressly disclose transmitting a connection request that includes a user ID from an information terminal of said user to said network provider, however, the Applicant has admitted that this subject matter was well known in the art at the time the invention was made. Therefore, it would have been obvious to one of ordinary skill in the art to include this well known subject matter with the teachings of Ahmad since it was within the level and knowledge of one of ordinary skill to transmit a connection request that includes a user ID from an information terminal of said user to said network provider.

Claims 4-7 are also rejected since claims 4-7 recite an information distribution method, system, software product, and program storage device that recite substantially the same limitations as recited in claim 1.

Regarding claim 2, Ahmad discloses an information distribution method for transmitting information to an

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information terminal connected via a network, comprising the steps of:

a user, who employs a network via a network provider under a condition of payment of a connection fee, transmitting a connection request to said network provider; ("logs on to Internet"; column 7, lines 33-39; column 8, lines 54-57)

transmitting a service menu screen ("Internet site"), which is an initial screen, from said network provider to said information terminal of said user; transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; transmitting, when said file server receives said connection request, to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading service menu ("rental form"); determining whether a program key ("software module"), uniquely identifying a program type at said network provider (column 3, lines 45-61), is present at said information terminal (column 11, lines 4-11), and where said program key is not found to presented, transmitting, when said user selects the downloading of a desired file from said service menu, a file downloading request

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from said information terminal of said user to said network provider; (column 8, line 54-60; column 9, lines 38-44)

generating a license key ("licensing information"), based on specified downloaded program information ("program module"), that is associated with said desired file that is selected by said user and with said user ID that is specified for said IP address included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a license condition for a downloaded program ("CICO module"); (column 9, lines 58-62; column 10, lines 21-34)

downloading to said information terminal said license key, said program key, and said selected program file (column 11, lines 4-11), said program file being capable of referring to said downloaded license key when said downloaded program is activated or executed, and capable of disabling at least a part of the function of said downloaded program, when said program matches a predetermined said licensing condition provided by reference (column 9, lines 45-49; column 10, lines 21-34)

transmitting said downloaded program specifying information from said information terminal of said user to said network provider; based on said user ID and said received downloaded program specifying information generating information from which a new license key can be generated; and transmitting said new

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license key to said information terminal of said user said information from which a new license key can be generated and generating a new license key at said information terminal of the user. (column 3, lines 20-61; column 14, line 66-column 15, line 5)

Ahmad does not expressly disclose wherein a user, who obtains a user ID and a password and employs a network via a network provider under a condition of payment of a connection fee, activating a dialer at said information terminal, entering said user ID, said password and a telephone number for accessing said network provider, and transmitting a connection request to said network provider; checking, upon the receipt of said connection request for said network provider, said user ID and said password that are included in said connection request; transmitting, when the results obtained by the check are negative, a message used to notify said user of a connection failure; assigning, when the results obtained by the check are affirmative, an IP address to said information terminal of said user, and registering a set consisting of said user ID and said correlated IP address; transmitting said IP address assigned for said information terminal of said user; and disconnecting said information terminal of said user from said network provider.

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However, this subject matter was admitted by the Applicant and therefore it would have been within the level and knowledge of one of ordinary skill in the art at the time the invention was made to perform these steps in order to use a modem in order to remotely connect to a server in order to effect connecting to the Internet as is conventionally known in the art.

Regarding claim 3, Ahmad discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

a user, who employs a network via a network provider under a condition of payment of a connection fee, transmitting a connection request to said network provider; ("logs on to Internet"; column 7, lines 33-39; column 8, lines 54-57)

transmitting a service menu screen ("Internet site"), which is an initial screen, from said network provider to said information terminal of said user; transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; transmitting, when said file server receives said connection request, to said information terminal of said user a file downloading service menu or a menu that can be introduced into

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said file downloading service menu ("rental form"); determining whether a program key ("software module"), uniquely identifying a program type at said network provider (column 3, lines 45-61), is present at said information terminal (column 11, lines 4-11), and where said program key is not found to presented, transmitting, when said user selects the downloading of a desired file from said file downloading service menu, a file downloading request from said information terminal of said user to said network provider; (column 8, line 54-60; column 9, lines 38-44)

generating a license key ("licensing information"), based on specified downloaded program information ("program module"), that is associated with said desired file that is selected by said user and with said user ID that is specified for said IP address included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a license condition for a downloaded program ("CICO module"); (column 9, lines 58-62; column 10, lines 21-34)

registering a user ID and said downloaded program specifying information with which said user ID is correlated; (column 9, lines 38-44)

downloading to said information terminal said license key, said program key, and said selected program file (column 11,



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lines 4-11), said program file being capable of referring to said downloaded license key when said downloaded program is activated or executed, and capable of disabling at least a part of the function of said downloaded program, when said program matches a predetermined said licensing condition provided by reference (column 9, lines 45-49; column 10, lines 21-34)

searching for said downloaded program specifying information that is registered while correlated with said user ID; based on said user ID and said received downloaded program specifying information generating information from which a new license key can be generated; and transmitting said new license key to said information terminal of said user said information from which a new license key can be generated and generating a new license key at said information terminal of the user.

(column 3, lines 20-61; column 14, line 66-column 15, line 5)

Ahmad does not expressly disclose wherein a user, who obtains a user ID and a password and employs a network via a network provider under a condition of payment of a connection fee, activating a dialer at said information terminal, entering said user ID, said password and a telephone number for accessing said network provider, and transmitting a connection request to said network provider; checking, upon the receipt of said connection request for said network provider, said user ID and

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said password that are included in said connection request; transmitting, when the results obtained by the check are negative, a message used to notify said user of a connection failure; assigning, when the results obtained by the check are affirmative, an IP address to said information terminal of said user, and registering a set consisting of said user ID and said correlated IP address; transmitting said IP address assigned for said information terminal of said user; and disconnecting said information terminal of said user from said network provider.

However, this subject matter was admitted by the Applicant and therefore it would have been within the level and knowledge of one of ordinary skill in the art at the time the invention was made to perform these steps in order to use a modem in order to remotely connect to a server in order to effect connecting to the Internet as is conventionally known in the art.

### **Conclusion**

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the

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entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and nonpreferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The


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examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100